

### **AMENDMENTS TO THE DRAWINGS**

The attached "Replacement Sheet" of drawings includes changes to Figure 4. The attached "Replacement Sheet," which includes Figure 4, replaces the original sheet including Figure 4.

Attachment: Replacement Sheet

## **REMARKS**

Reconsideration of the present application is requested. Claims 1 and 11-21 have been amended. Claims 1-31 are currently pending, and of those, claims 1, 11 and 22 are independent claims.

### **INFORMATION DISCLOSURE STATEMENT**

Applicants acknowledge the Examiner's consideration of the Information Disclosure Statements filed December 13, 2002 and June 5, 2002.

### **ALLOWABLE SUBJECT MATTER**

Applicants acknowledge the Examiner's indication of the allowable subject matter set forth in claims 1-31.

### **REJECTION UNDER 35 U.S.C. § 101**

The Examiner rejects claims 1-21 under 35 U.S.C. § 101. Although Applicants do not necessarily agree with the Examiner, in an effort to expedite prosecution of the present application, Applicants have amended claims 1 and 11 to alleviate these rejections.

Withdrawal of this rejection is kindly requested.

### **REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Examiner rejects claims 1-21 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. In particular, the Examiner submits that the specification fails to describe "how to receive a selection by a user of the project planning tool," "how to receive a specified at least one further description of the project planning tool," and "how to assign an installation priority number." See, Office Action, pp. 3. Applicants disagree.

As outlined in MPEP § 2164, 35 U.S.C. § 112, first paragraph requires that the specification adequately describe the invention such that **one skilled in the relevant art** (not the Examiner) can make and use the claimed invention. Applicants are not required to "enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment." *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003).

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable **one skilled in the pertinent art** (again, not the Examiner) to make and use the claimed invention. **A patent need not teach, and preferably omits, what is well known in the art.** *E.g., In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

In order to make this rejection, the examiner has the **initial burden to establish a reasonable basis to question the enablement provided for the claimed invention**. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (**examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure**).

At a minimum, the Examiner is required to provide reasons for the uncertainty of the enablement. See, MPEP § 2164.04. For example, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. See, MPEP § 2164.06(a). Specific technical reasons to this effect are always required.

In the Office Action, however, the Examiner has failed to do so.

Absent a reason to doubt that the specification is enabling, the specification **must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph**. See, MPEP § 2164.04.

As discussed in paragraphs [0017 – 0019] of Applicants' specification, customary input units 9 and 10 (e.g., a keypad 9, a mouse 10) are examples of devices, which permit (e.g., enable, allow, etc.) the selecting, specifying or assigning of claim 1. The skilled artisan would clearly understand how the selection by a user, a specified at least one further description, and assignment an installation priority number may be received.

For at least the above reasons, withdrawal of this rejection is kindly requested.

**REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claims 22-32 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being incomplete for omitting essential elements. In particular, the Examiner submits that claims 22-32 omit elements for "permitting," as set forth in claim 22.

Initially, Applicants fail to understand what essential elements are missing from claim 22, and prompted the Examiner's rejection. As recited in claim 22, the "selection means," permits a user of the project planning tool to "select at least one catalog," and specify "at least one further description."

In one example-non-limiting embodiment, input units 9 and 10 (e.g., a keypad 9, a mouse 10) permit selection of at least one catalog and specification of at least one further description.

For at least this reason, Applicants submit that claim 22 is fully in accordance with 35 U.S.C. § 112, second paragraph.

Withdrawal of this rejection is requested.

**CONCLUSION**

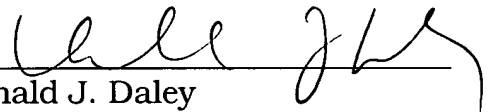
In view of above remarks, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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